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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196				EXAMINER LOFTIN, CELESTE
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/530,309	BAKRI, BAN AL	
	Examiner Celeste L. Loftin	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 October 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 04 April 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. _____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/04/2005</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 9-11, 18 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagadeesan, US Patent 7,003,298.

Regarding claim 1, Jagadeesan discloses a method of handing over a subscriber unit from a first cellular communication system supporting a plurality of connections of the subscriber unit to a second cellular communication system (having capability for supporting only one connection), the method comprising

entering at least a first connection of said plurality of connections into a holding state (the signal to begin handoff is transmitted over the original leg (first connection) and a telephone call is made to establish connection, it is inherent to one skilled in the art that this would pause the original transmissions) (**col. 7 lines 35-45**);
forming a handover connection to the subscriber unit through the second cellular communication system (a handoff call is made to the access address, the handoff call is made responsive to the receiving the address signal) (**col. 7 lines 55-65**);
handing over a second connection of said plurality of connections to the second

cellular communication system by associating the second connection with said handover connection (the alternate leg of the telephone call connection is established from the handoff the alternate leg is coupled with the voice channel (a second connection)) (**col. 7 lines 60-67**);
entering said at least first connection into an active state by associating the at least first connection with the handover connection (data can be received from both the original leg and the alternate leg) (**col. 8 lines 10-19**).

Regarding claim 9, Jagadeensan disclose a method as claimed in claim 1 further comprising notifying a user of the subscriber unit of which of the plurality of connections are in a holding state (the modality handoff signal may be performed by transmitting it to the remote device over the original leg (meaning placing the voice communication on hold)) (**col. 7 line 35-45**).

Regarding claim 10, Jagadeensan discloses a method as claimed in claim 1 wherein at least one of the plurality of connections is between the subscriber unit and a second cellular communication unit and further comprising notifying a user of the second cellular communication unit of which of the plurality of connections are in a holding state (the modality handoff signal may be performed by transmitting it to the remote device over the original leg (meaning placing the voice communication on hold)) (**col. 7 line 35-45**).

Regarding claim 11, Jagadeensan discloses a method as claimed in claim 9 wherein the notification is by means of a voice communication if at least one of the plurality of connections is a voice service connection (the voice channel is coupled with the original leg, the voice channel may be internal within a device and terminates in at least one of a speaker and a microphone) (**col. 7 lines 25-30**).

Regarding claim 18, Jagadeensan discloses method as claimed in claim 1 wherein the plurality of connections is circuit switched connections (according to an optional next box the original leg is coupled with a voice channel for transferring data it could be used over a circuit switched or packet switched network) (**col. 7 lines 25-35**).

Regarding claim 25. A apparatus for handing over a subscriber unit from a first cellular communication system supporting a plurality of connections of the subscriber unit to a second cellular communication system (having capability for supporting only one connection); the apparatus comprising:

means for entering at least a first connection of said plurality of connections into a holding state (the signal to begin handoff is transmitted over the original leg (first connection) and a telephone call is made to establish connection, it is obvious to one skilled in the art that this would pause the original transmissions) (**col. 7 lines 35-45**);
means for forming a handover connection to the subscriber unit through the second cellular communication system (a handoff call is made to the access address, the handoff call is made responsive to the receiving the address signal) (**col. 7 lines 55-65**);

means for handing over a second connection of said plurality of connections to the second cellular communication system by associating the second connection with said handover connection (the alternate leg of the telephone call connection is established from the handoff the alternate leg is coupled with the voice channel (a second connection)) (**col. 7 lines 60-67**);

means for entering said at least first connection into an active state by associating the at least first connection with the handover connection (data can be received from both the original leg and the alternate leg) (**col. 8 lines 10-19**).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-8, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagadeesan, US Patent 7,003,298, in view of Tellinger et al. (Tellinger), US Patent 6,792,273.

Regarding claim 3, Jagadeesan discloses a method as claimed in claim 1, but fails to disclose further comprising selecting the second connection from the plurality of connections in response to at least one characteristic of at least one of the plurality of connections.

In a similar field of endeavor, Tellinger discloses disclose further comprising selecting the second connection from the plurality of connections in response to at least one characteristic of at least one of the plurality of connections (when a request is received at the communications controller on or more services are requested with that connection, such as a peak rate, bit rate, or delay, the resource handler determines and reserves those hardware and or software resources to needed to support the requested service) (col. 7 lines 1-25, 35-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeesan to include disclose further comprising selecting the second connection from the plurality of connections in response to at least one characteristic of at least one of the plurality of connections. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 4, the combination discloses a method as claimed in claim 3. Tellinger

further discloses wherein the characteristic is related to a type of connection (when a request is received at the communications controller on or more services are requested with that connection, the resource handler reserves those hardware and software resources needed to support the requested service (i.e. data)) (**col. 7 lines 1-25, 35-50**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination to include disclose wherein the characteristic is related to a type of connection. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 5, the combination discloses a method as claimed in claim 4. Tellinger further discloses wherein selecting comprises selecting a data service connection in preference to a voice service connection as the second connection (when a request is received at the communications controller on or more services are requested with that connection, the resource handler reserves those hardware and software resources needed to support the requested service (i.e. data)) (**col. 7 lines 1-25, 35-50**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination to include discloses wherein selecting comprises selecting a data service connection in preference to a voice service connection as the second connection. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 6, the combination discloses a method as claimed in claim 3 wherein the at least one characteristic comprises at least one characteristic chosen from the group consisting of a) a priority;

b) a data rate;

c) a propagation characteristic (when a request is received at the communications controller on or more services are requested with that connection, such as a peak rate, bit rate, or delay, the resource handler determines and reserves those hardware and or software resources to needed to support the requested service) (col. 7 lines 1-25, 35-50).;

d) an error rate;

e) a transaction identifier; and

f) a time of setup of at least one of the plurality of connections.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination to include a) a priority; b) a data rate; c) a propagation characteristic d) an error rate; e) a transaction identifier; and f) a time of setup of at least one of the plurality of connections. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 7, Jagadeensan discloses a method as claimed in claim 1 but fails to disclose wherein the at least first connection is a data connection and the method comprises storing data of the at least first connection in memory when the at least first connection is in the holding state; and

communicating the data stored in said memory when the at least first connection enters the active state.

In a similar field of endeavor, Tellinger discloses wherein the at least first connection is a data connection and the method comprises storing data of the at least first connection in memory when the at least first connection is in the holding state; and communicating the data stored in

said memory when the at least first connection enters the active state (the DHO unit is assembled into radio frames that are split and sent to the base stations (connections) involved in the diversity handover, this process includes storing received radio frames from different soft handover paths in input buffers and forwarding chosen radio frame data to the overlaying protocol layer) (**col. 6 lines 25-40**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include storing data of the at least first connection in memory when the at least first connection is in the holding state; and communicating the data stored in said memory when the at least first connection enters the active state. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 8, Jagadeensan discloses a method as claimed in claim 1 but fails to disclose wherein the at least first connection is a data connection and the method comprises storing data of the at least first connection in memory when the at least first connection is in the holding state; and

the subscriber unit retrieving the stored data from the memory by setting up a separate data call.

In a similar field of endeavor, Tellinger discloses wherein the at least first connection is a data connection and the method comprises storing data of the at least first connection in memory when the at least first connection is in the holding state (the DHO unit is assembled into radio frames that are split and sent to the base stations (connections) involved in the diversity handover, this process includes storing received radio frames from different soft handover paths

in input buffers and forwarding chosen radio frame data to the overlaying protocol layer) (**col. 6 lines 25-40**); and the subscriber unit retrieving the stored data from the memory by setting up a separate data call (the resource handler then allocates for the mobile connection data (requested by the mobile station) processing and memory and/or other resources based on the determined station and parameters) (**col. 7 lines 1-25**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include storing data of the at least first connection in memory when the at least first connection is in the holding state; and the subscriber unit retrieving the stored data from the memory by setting up a separate data call. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 12, Jagadeenson discloses a method as claimed in claim 1 but fails to disclose further comprising selecting the second connection in response to a parameter set by an operator of at least one of the first or second cellular communication systems.

In a similar field of endeavor, Tellinger discloses further comprising selecting the second connection in response to a parameter set by an operator of at least one of the first or second cellular communication systems (when a request is received at the communications controller on or more services are requested with that connection, such as a peak rate, bit rate, or delay, the resource handler determines and reserves those hardware and or software resources to needed to support the requested service) (**col. 7 lines 1-25, 35-50**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include disclose further comprising selecting the second connection in

response to a parameter set by an operator of at least one of the first or second cellular communication systems. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 13, Jagadeenson discloses a method as claimed in claim 1 but fails to disclose further comprising selecting the second connection in response to a parameter set by a user of the subscriber unit.

In a similar field of endeavor, Tellinger discloses further comprising selecting the second connection in response to a parameter set by a user of the subscriber unit (when a request is received at the communications controller on or more services are requested with that connection, such as a peak rate, bit rate, or delay, the resource handler determines and reserves those hardware and or software resources to needed to support the requested service) (**col. 7 lines 1-25, 35-50**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include disclose further comprising selecting the second connection in response to a parameter set by a user of the subscriber unit. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

Regarding claim 14, Jagadeenson discloses a method as claimed in claim 1 but fails to disclose wherein if the handover to the second cellular communication system is unsuccessful at least one of the plurality of connections is re-established through the first cellular communication system.

In a similar field of endeavor, Tellinger discloses further comprising wherein if the handover to the second cellular communication system is unsuccessful at least one of the plurality of connections is re-established through the first cellular communication system (when a request is received at the communications controller on or more services are requested with that connection, such as a peak rate, bit rate, or delay, the resource handler determines and reserves those hardware and or software resources to needed to support the requested service) (col. 7 lines 1-25, 35-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include disclose further comprising comprising wherein if the handover to the second cellular communication system is unsuccessful at least one of the plurality of connections is re-established through the first cellular communication system. Motivation for this modification would have been to know the dynamic connection parameters of the connection likely to be involved in supporting the connection.

5. Claims 16,17, and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagadeesan, **US Patent 7,003,298**, in view of Parmar et al. (Parmar), **US Patent 6,725,039**.

Regarding claim 16, Jagadeensan discloses a method as claimed in claim 1, but fails to disclose wherein the method is operated in a single integrated master switch centre for the first cellular communication system and the second cellular communication system.

In a similar field of endeavor, Parmar discloses wherein the method is operated in a single integrated master switch centre for the first cellular communication system and the second cellular communication system (provides a method of processing a handover request from a base

station controller of a GSM network, the method comprising passing a handover request with GSM parameters from a base station controller through a master switching centre to a UMTS core network) (**col. 1 lines 40-50**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the method is operated in a single integrated master switch centre for the first cellular communication system and the second cellular communication system. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 17, Jagadeensan discloses a method as claimed in claim 1 but fails to disclose wherein the second cellular communication system is operable to only support one connection for each served subscriber unit.

In a similar field of endeavor, Parmar discloses wherein the second cellular communication system is operable to only support one connection for each served subscriber unit (potential links supplied in a list to the UE on satisfactory communication is not possible are deleted from the list of available links of performing soft handover from a GSM network to a UMTS network comprising supplying a list of potential access nodes to user equipment) (**col. 2 lines 60-67 and col. 3 lines 1-5**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the second cellular communication system is operable to only support one connection for each served subscriber unit. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 19, Jagadeensan disclose a method as claimed in claim 1, but fails to disclose wherein the second cellular communication system is a Second Generation Cellular Communication System.

In a similar field of endeavor, Parmar discloses wherein the second cellular communication system is a Second Generation Cellular Communication System (potential links supplied in a list to the UE on satisfactory communication is not possible are deleted from the list of available links of performing soft handover from a GSM network to a UMTS network comprising supplying a list of potential access nodes to user equipment) (**col. 2 lines60-67 and col. 3 lines 1-5**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the second cellular communication system is a Second Generation Cellular Communication System. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 20, the combination discloses a method as claimed in claim 19. Parmar further discloses wherein the second cellular communication system is a Global System for Mobile communication (GSM) cellular communication system (potential links supplied in a list to the UE on satisfactory communication is not possible are deleted from the list of available links of performing soft handover from a GSM network to a UMTS network comprising supplying a list of potential access nodes to user equipment) (**col. 2 lines60-67 and col. 3 lines 1-5**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the second cellular communication system is a Global

System for Mobile communication (GSM) cellular communication system. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 21, Jagadeensan disclose a method as claimed in claim 1, but fails to disclose wherein the first cellular communication system is a Third Generation Cellular Communication System.

In a similar field of endeavor, Parmar discloses wherein the first cellular communication system is a Third Generation Cellular Communication System (potential links supplied in a list to the UE on satisfactory communication is not possible are deleted from the list of available links of performing soft handover from a GSM network to a UMTS network comprising supplying a list of potential access nodes to user equipment) (**col. 2 lines 60-67 and col. 3 lines 1-5**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the first cellular communication system is a Third Generation Cellular Communication System. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 22, the combination discloses a method as claimed in claim 21. Parmar further discloses wherein the first cellular communication system is a Universal Mobile Telecommunication System (UMTS) (potential links supplied in a list to the UE on satisfactory communication is not possible are deleted from the list of available links of performing soft handover from a GSM network to a UMTS network comprising supplying a list of potential access nodes to user equipment) (**col. 2 lines 60-67 and col. 3 lines 1-5**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeensan to include wherein the first cellular communication system is a Universal Mobile Telecommunication System (UMTS). Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 23, the combination discloses a method as claimed in claim 22. Parmar further discloses wherein entering the at least first connection into a holding state is performed in accordance with at least one of the 3.sup.rd Generation Partnership Project (3G PP) Technical Specifications 22.083, 23.083 and 24.083 (it is known in the art that that is a standard when using 3GPP).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination to include wherein entering the at least first connection into a holding state is performed in accordance with at least one of the 3.sup.rd Generation Partnership Project (3G PP) Technical Specifications 22.083, 23.083 and 24.083. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

Regarding claim 24, the combination discloses a method as claimed in claim 22. Parmar further discloses wherein entering said at least first connection into an active state is performed in accordance with the 3.sup.rd Generation Partnership Project (3G PP) Technical Specification 24.083 (it is known in the art that that is a standard when using 3GPP).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination to include wherein entering said at least first connection into an active state is performed in accordance with the 3.sup.rd Generation Partnership Project (3G PP)

Technical Specification 24.083. Motivation for this modification would have been to provide a method that can applicable to one or more networks.

6. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagadeesan, US Patent 7,003,298, in view of Bedingfield, SR. et al. (Bedingfield), US Patent 5,850,606.

Regarding claim 2, Jagadeesan discloses a method as claimed in claim 1 but fails to disclose wherein entering said at least first connection into an active state comprises switching the handover connection from being with the second connection to being with the at least first connection.

In a similar field of endeavor, Bedingfield discloses wherein entering said at least first connection into an active state comprises switching the handover connection from being with the second connection to being with the at least first connection (after connection is established in the handover old connection is released to be available for future use in association with future calls (it is obvious to one of ordinary skill in the art that this connection can be associated with the handover connection)) (col. 11 lines35-46).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeesan to include discloses wherein entering said at least first connection into an active state comprises switching the handover connection from being with the second connection to being with the at least first connection. Motivation for this modification would have been to provide a method that can applicable to one or more networks or a group of units.

Regarding claim 15, Jagadeensan discloses a method as claimed in claim 1 but fails to disclose wherein the second cellular communication system comprises a master switch center

comprising functionality for selecting the second connection out of the plurality of connections.

In a similar field of endeavor, Bedingfield discloses wherein the second cellular communication system comprises a master switch center-comprising functionality for selecting the second connection out of the plurality of connections (after connection is established in the handover old connection is released to be available for future use in association with future calls (it is obvious to one of ordinary skill in the art that this connection can be associated with the handover connection)) (**col. 11 lines35-46**).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jagadeesan to include discloses wherein the second cellular communication system comprises a master switch center comprising functionality for selecting the second connection out of the plurality of connections. Motivation for this modification would have been to provide a method that can applicable to one or more networks or a group of units.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celeste L. Loftin whose telephone number is 571-272-2842. The examiner can normally be reached on Monday thru Friday 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL

Jay K. Contee
PATENT EXAMINER